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In re Application of  
LABRIE, Craig B *et al*  
U.S. Application No.: 09/786,305  
PCT No.: PCT/US99/13592  
Int. Filing Date: 16 June 1999  
Priority Date: 19 June 1998  
Attorney Docket No.: TRM DV2539  
For: APPARATUS FOR DEPLOYING AN  
AIR BAG . . .

\*DECISION ON  
PETITION UNDER  
37 CFR 1.47(a)

This is a decision on applicants' "Petition Under PCT Rule 4.15(b) and 37 CFR 1.425 to Accept Filing Where One Inventor Refuses to Sign the Request and Two Inventors Cannot be Located" ("Pet.") filed 08 November 2001. This is treated as a petition pursuant to 37 CFR 1.47(a).

### **BACKGROUND**

On 08 May 2001, the United States Designated/Elected Office (DO/EO/US) mailed a Notification of Missing Requirements under 35 U.S.C. 371 (Form PCT/DO/EO/905) indicating that an oath/declaration in compliance with 37 CFR 1.497(a) and (b) and a surcharge fee pursuant to 37 CFR 1.492(e) must be provided. Applicants were given two months to respond. Extensions of time were available under 37 CFR 1.136(a).

On 08 November 2001, applicants submitted the instant petition which was accompanied by, *inter alia*, a four-month extension and \$1,440.00 fee; the \$130.00 surcharge fee; and a declaration signed by seven of the ten co-inventors.

On 13 December 2001, the DO/EO/US mailed a Notification of Abandonment.

### **DISCUSSION**

The Notification of Abandonment was mailed before the instant response was processed. Accordingly, the Notification of Abandonment mailed 13 December 2001 is hereby **VACATED**.

**Inventor(s) Refuse to Sign/Cannot be Located**

In the instant response, applicant requests that "the present application be processed according to the Patent Cooperation Treaty and 37 CFR 1.425." Pet. ¶ 8. This is not possible.

PCT Rule 4.15 and 37 CFR 1.425 apply only to international applications. In addition, section 1893.01(e) of the Manual of Patent Examining Procedure (MPEP) discusses the oath/declaration requirements in U.S. National Applications filed under 35 U.S.C. 371 and states, in part that:

If an inventor refuses to execute the oath or declaration or is unavailable, applicant must file an oath or declaration and a petition in accordance with 37 CFR 1.47.

Here, applicants are entering the national phase pursuant to 35 U.S.C. 371. Seven of the ten listed inventors have signed the declaration. Since at least one co-inventor signed the declaration, applicants must satisfy the requirements of 37 CFR 1.47(a).

A petition under 37 CFR 1.47(a) must be accompanied by: (1) the required petition fee; (2) factual proof that the missing joint inventor(s) refuses to execute the application or cannot be found or reached after diligent effort; (3) a statement of the last known address of the missing joint inventor(s); (4) and an oath or declaration executed by the signing joint inventor on his behalf and on behalf of the non-signing joint inventor.

The required petition fee of \$130.00 as set forth in 37 CFR 1.17(i) has been charged to Deposit Account No. 08-1391 as authorized. Item (1) is complete.

Regarding item (3), the address of Craig B. Labrie, John J. Kennedy, and Vernon A. Daniels are all listed on the declaration. These addresses have been construed as a statement of the last known address of each co-inventor. If this is not correct, applicants must notify the Office as soon as possible.

Mr. Labrie's address is listed as:

59 Upper Factory Road  
Dover, N.H. 03820

Mr. Kennedy's address is listed as:

920 Irving  
Royal Oak, MI 48067

Mr. Daniels address is listed as:

160 Channes Circle  
Brooklyn, MI 40230

Concerning item (4), MPEP § 409.03(a) states, in part:

An oath or declaration signed by all the available joint inventors with the signature block of the nonsigning inventor(s) left blank may be treated as having been signed by all the available joint inventors on behalf of the nonsigning inventor(s), unless otherwise indicated.

In the instant petition, applicants included a declaration signed by seven of the ten co-inventors. All the co-inventors' names, residences, post office addresses and citizenship are typed on the declaration. This declaration satisfies the requirements of section 409.03(a) of the MPEP, and is in compliance with 37 CFR 1.497(a) and (b). Therefore, item (4) is satisfied

However, applicants failed to satisfy item (2).

Applicants first state that "in spite of repeated efforts, the undersigned was unable to obtain the signature of co-inventor Daniels on the enclosed Declaration as co-inventor Daniels refuses to sign." *Id.* ¶ 4. Section 409.03(d) of the MPEP explains what is required to prove a refusal by an inventor and states, in part:

When it is concluded by the 37 CFR 1.47 applicant that a nonsigning inventor's conduct constitutes a refusal, all facts upon which that conclusion is based should be stated in an affidavit or declaration. If there is documentary evidence to support facts alleged in the affidavit or declaration, such evidence should be submitted. Whenever a nonsigning inventor gives a reason for refusing to sign the application oath or declaration, that reason should be stated in the affidavit or declaration.

Then, applicants declared that "in spite of repeated efforts, the undersigned was unable to locate co-inventors Labrie and Kennedy, and was therefore unable to obtain the signatures of co-inventors Labrie and Kennedy." *Id.* at ¶ 5. Applicants' burden in proving that an inventor cannot be located pursuant to item (2) is explained in section 409.03(d) of the MPEP which states, in part:

Where inability to find or reach a nonsigning inventor "after diligent effort" is the reason for filing under 37 CFR 1.47, a statement of facts should be submitted that fully describes the exact facts which are relied on to establish that a diligent effort was made . . .

The statement of facts must be signed, where at all possible, by a person having firsthand knowledge of the facts recited therein. Statements based on hearsay will not normally be accepted. Copies of documentary evidence such as internet searches, certified mail return receipts, cover letters of instructions, telegrams, that support a finding that the nonsigning inventor could not be found or reached should be made part of the statement. The steps taken to locate the whereabouts of the nonsigning inventor should be included [in the] statement of facts. It is important that the statement contain facts as opposed to conclusions.

In the instant petition, applicants did not submit a declaration or affidavit by a person having firsthand knowledge of the facts, or provide documentary evidence as required above. Moreover, applicants also need to show that a *bona fide* attempt was made to present a copy of the application papers (specification, including claims, drawings, and oath or declaration) to the nonsigning inventor, Mr. Daniels, for a signature. For these reasons, item (2) is not satisfied.

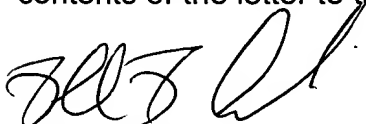
Therefore, all of the requirements of 37 CFR 1.47(a) are not yet complete.

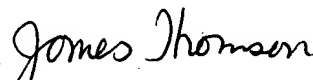
#### **CONCLUSION**

The petition under 37 CFR 1.47(a) is **DISMISSED** without prejudice.

If reconsideration on the merits of this petition is desired, a proper response must be filed within **TWO (2) MONTHS** from the mail date of this decision. Extensions of time may be obtained under 37 CFR 1.136(a).

Please direct further correspondence with respect to this matter to the Assistant Commissioner for Patents, Box PCT, Washington, D.C. 20231, and address the contents of the letter to the attention of the PCT Legal Office.

  
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